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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,909	07/31/2003	Gary K. Kuhn	56295US004	9634
32692	7590	07/01/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			GRAY, LINDA LAMEY	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/631,909	KUHN	
	Examiner Linda L Gray	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 April 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-7, 9-17, 19 and 20 is/are rejected.
- 7) Claim(s) 8 and 18 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>XPK</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-7, 9-17, and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Reed (US 4,246,058).

Claims 1 and 19, Reed teaches a method of applying tape 18 to a surface including the following steps:

- (a)** providing the tape, wherein the tape includes a tape backing 12 and an adhesive 16 on the tape backing 12, and wherein the tape is on a liner 14;
- (b)** cutting the tape to provide a first length of tape 18, a second length of tape 18, and a removable portion 20 of the tape located between the first length of tape 18 and the second length of tape 18;
- (c)** removing the removable portion 20 of the tape from the liner 14;
- (d)** separating the first length of tape 18 from the liner 14; and
- (e)** applying the first length of tape 18 to the surface (c 2, L 40-59).

The new limitation of "having a simulated beveled, etched, or grooved appearance when applied to a glass surface" is an intended use limitation and does not provide a patentable method step over the prior art to Reed.

Claims 2 and 21, Reed teaches separating the second length of tape 18 from the liner 14 and applying the second length of tape 18 to the surface. **Claims 3-6 and 19,** Reed teaches that the removable portion 18 includes a first end and a second end opposite the first end, and wherein step **(b)** includes cutting a portion of the first end of the removable portion at an angle oblique to the length of the tape, see Figures 1 and 11, for example, where at both the first and second ends of the removable portion

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20 between the first and second lengths of tape 18 has curved portions (corners) which are oblique. The angles are less than 180 degrees.

Claim 9, the discussion of Reed applies herein. Note that Reed teaches winding the removable portions 20 onto a roll (Fig 6). Thus, the removable portions 20 are stacked upon each other via one layer of the roll upon another. Reed also teaches separating the second length of tape 18 from the liner 14 and applying the second length of tape 18 to the surface.

Claims 10-17 and 22, the above discussion of Reed applies herein.

Claim Rejections - 35 USC § 103

3. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reed.

Claims 7 and 17, the first and second lengths of tape 18 are labels. Reed does not specifically recite that such contains indicia (decoration).

However, it is conventional to have indicia on a tape which is later die cut into labels such that the print can be registered with the labels correctly, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Reed indicia on the tape.

Allowable Subject Matter

4. Claims 8 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter: **claims 8 and 18**, Reed does not teach that the surface to which the first and second lengths of tape 18 are applied is glass and has the function of providing a simulated beveled appearance.

6. As allowable subject matter has been indicated, Applicants' duty must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Comments

7. Applicant's comments filed 4-5-04 have been fully considered. Applicant indicates that Reed does not mention any material that would provide a simulated beveled, etched, or grooved appearance when applied to a glass surface. In response, this new limitation is an intended use limitation and does not provide a patentable method step over the prior art to Reed.

Applicant indicates that Reed does not teach cutting at an oblique angle. In response, see Figures 1 and 11 of Reed where at both the first and second ends of the removable portion 20 between the first and second lengths of tape 18 has curved portions (corners) which are oblique. The angles are less than 180 degrees.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Gray whose telephone number is (571) 272-1228. The examiner can normally be reached Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino, can be reached at (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

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more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

llg

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June 25, 2004

Linda D Gray
LINDA GRAY
PRIMARY EXAMINER